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APPLICATION NUMBER	FLING DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO.
08/649-419	05/16/96	RHOADS	G 48301-45000-11
EXAMINER			

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ART UNIT	PAPER NUMBER
2721	20

DATE MAILED: 03/12/98

3-12-98

This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 2/17/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 2-19 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 18
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Art Unit: 2721

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

2. The amendment filed December 15, 1997 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly amended material beginning on page 1, line 15, specifically the reference to the internet, creative asset, public media, how audio material proliferates online, a consistent program for the monitoring of public media (including the worldwide web), steganography as a basis for the marking of creative material, combined with an internet search facility designed to quickly and efficiently search for steganographic markings, resolving the steganography information using a database, and generating reports for owners/distributors in the process.

Applicant is required to cancel the new matter in the reply to this Office action.

3. Applicant's arguments with respect to claims 2-19 have been considered but are moot in view of the new ground(s) of rejection.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 2721

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. ('788) in view of Shear.

Powell et al. ('788) disclose a method and system for digital image signatures.

As to claim 2, Powell et al. ('788) provide for automatically downloading data, including empirical data sets, from a plurality of computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); for each of a plurality of empirical data sets obtained by the downloading operation, automatically screening same to identify the potential presence of identification data steganographically embedded therein (refer for example to column 5, line 49 through column 6, line 43); for each of a plurality of empirical data sets screened by the screening operation, discerning identification data, if any, steganographically encoded therein (refer for example to column 6, line 44 through column 7, line 14); and generating a report identifying steganographically encoded empirical data sets identified by the foregoing steps, and the site from which each was downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

Although Powell et al. ('788) do not specifically state that the image data is automatically downloaded from a plurality of computer sites over the internet, the automatically downloading of data is well known and widely utilized in the prior art.

Shear discloses a data base usage metering and protection system and method which specifically discusses the automatically downloading of data from a plurality of computer sites over the internet (refer for example to column 1, lines 33-49).

Art Unit: 2721

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for automatically downloading of data from a plurality of computer sites over the internet as taught by Shear in the Powell et al. ('788) system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

In regard to claims 3 and 12, Powell et al. ('788) provide for including a master code signal, and using the code signal in discerning the steganographically encoded identification data from the screened empirical data sets (refer for example to column 6, lines 18-43).

With regard to claims 4 and 13, Powell et al. ('788) provide for the master code signal to have the appearance of unpatterned snow if represented in the pixel domain (see figures 2, 3 and 5).

As to claims 5 and 14, Powell et al. ('788) provide for discerning of identification data from the downloaded empirical data to be accomplished without previous knowledge of the audio, image, or video information represented therein (refer for example to column 6, lines 18-43).

In regard to claims 6 and 15, Powell et al. ('788) provide for including identifying proprietors of empirical data sets by reference to identification data steganographically discerned therefrom, and reporting to the proprietors the sites from which their empirical data sets were downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

Art Unit: 2721

With regard to claims 7 and 16, Powell et al. ('788) provide for the identification data to include information in addition to data identifying the proprietor, and the method includes providing the additional data to the proprietors (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

As to claims 8 and 17, Powell et al. ('788) provide for the identification data is a serial number index to registry database containing names and contact information for proprietors identified by the identification data (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

In regard to claims 9 and 18, Powell et al. ('788) provide for the empirical data to include image data (as shown in figures 2, 3 and 5); and the method includes converting the image data to pixel form, if not already in the form (as shown in figure 2, 3 and 5); and performing a plurality of statistical analyses on the pixel form image data to discern the identification data therefrom (refer for example to column 6, lines 18-43).

With regard to claims 10 and 19, Powell et al. ('788) provide for each statistical analysis to include analyzing a collection of spaced apart pixels to decode a single, first bit of the identification data therefrom, the analysis to decode the first bit encompassing not just the spaced apart pixels, but also pixels adjacent thereto, the adjacent pixels not being encoded with the first bit (refer for example to column 6, lines 18-43).

As to claim 11, Powell et al. ('788) provide for providing a master code signal useful for detecting steganographic coding within empirical data sets (refer for example to column 6, lines 18-43); automatically downloading data, including empirical data sets, from a plurality of computer sites (refer for example to

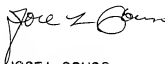
Art Unit: 2721

column 1, lines 12-21 and column 2, line 60 through column 3, line 17); for each of a plurality of empirical data sets obtained by the downloading operation, discerning certain identification data, if any, steganographically encoded therein, the discerning employing the master code signal as a decoding key (refer for example to column 5, line 49 through column 6, line 43); and generating a report identifying steganographically empirical data sets identified by the foregoing steps, and the site from which each was downloaded (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this Group is (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.


JOSE L. COUSO
PRIMARY EXAMINER

jlc
March 4, 1998